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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,504	01/25/2002	John H. Westerbeke JR.	00637-031001	4878
26161	7590	03/10/2005	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			ELKASSABGI, HEBA	
			ART UNIT	PAPER NUMBER
			2834	

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,504

Applicant(s)

WESTERBEKE, JOHN H.

Examiner

Heba Elkassabgi

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-26 and 28-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24,26,29,31,34,-35,38,40 is/are rejected.
- 7) ☒ Claim(s) 25,28,30,32,33,37,39,41,43,44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim limitation of "to perform useful work", is vague and indefinite and needs to be further clarified as to what the applicant means as useful, any work can be useful in one way or another.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 24, 26, 29, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Mabru (US Patent 6435925).

Mabru discloses in figures 2-3 a marine electrical power generator (61) having a four-stroke, water-cooled engine (2) with a vertically oriented drive shaft (crank shaft, 22) and an exhaust system (6) including an exhaust riser extending to above a water line of the hull. A permanent magnet alternator (3) with a cup-shaped rotor (34) mounted at one end of the engine drive shaft (22) to produce electricity; and a transportable frame (60, cover assembly) upon which the engine (4) and alternator (3) are mounted. The platform defining mounting points (16) for securing the generator inside the boat hull; wherein the rotor (34) carries an arrangement of permanent magnets attached to an inner circumferential surface of the rotor. In regards to claim 26, the generator has an enclosure (housing 1) surrounding the engine (4) and alternator (3). In regards to claim 29, the alternator (3) includes a stationary, wound stator (32) responsive to the moving magnetic fields generated by the rotor (34) and packaged within the rotating rotor. In regards to claim 31, the engine (4) is designed for use in a vertical shaft (22) configuration in outboard marine motors.

Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Mabru (US Patent 6435925).

Mabru discloses in figures 2-3 a crankshaft (22) of an outboard motor engine (4) to an electrical generator (61) with a permanent magnet alternator (3) having a cup-shaped rotor (34) mounted at one end of the engine drive shaft (22) carrying an arrangement of permanent magnets attached to an inner circumference of the alternator (3) mounting the engine (2) and generator (61) within a hull of a boat, in order to run the engine to produce electrical power and direct electrical power from the generator (61) to a remote electrical load to perform useful work.

Claim 35,38 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Mabru (US Patent 6435925).

Mabru discloses in figures 2-3 a marine electric power generator (61) having a four-stroke, water-cooled engine (4) with a vertically oriented drive shaft (22) and an exhaust system (6) having an exhaust riser extending to above a water line of the hull. An alternator (3) with a vertically oriented rotor (34) coupled for rotation with the engine drive shaft (22) to produce electricity and laterally spaced from the engine shaft (not shown) and a transportable frame (60) upon which the engine (4) and alternator (3) are mounted in side-by-side relation. In regards to claim 35, an exhaust rise extending to an exhaust outlet disposed on the hull. In regards to claim 38, the generator has an enclosure (housing 1) surrounding the engine (4) and alternator (3). In regards to claim 40, the alternator (3) has a stationary wound stator (32) responsive to the moving

magnetic fields generated by the rotor (34) and packaged within the rotating rotor. In regards to claim 42, the engine (4) is designed for use in a vertical shaft (22) configuration in outboard marine motors.

Allowable Subject Matter

Claims 25,28,30,32,33,37,39,41,43, and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Dependent claims 25 and 37 are allowed over the prior art, which does not disclose a combination of independent claims 24 and 35 with the generator being mounted below a deck of the boat.

Dependent claims 28 and 39 are allowed over the prior art, which does not disclose a combination of independent claims 24 and 35 with a weight and position of the magnets are selected to balance firing impulses and radial accelerations of the engine and its rotating components.

Dependent claims 30 and 41 are allowed over the prior art, which does not disclose a combination of independent claims 24 and 35 with a seawater pump mounted on another end of the engine drive shaft.

Dependent claims 32 and 43 are allowed over the prior art, which does not disclose a combination of independent claim 24 and 35 with a generator having an overall height of less than about 15 inches.

Dependent claims 33 and 44 are allowed over the prior art, which does not disclose a combination of independent claim 24 and 35 with a generator having an overall height of less than about 12 inches.

Response to Arguments

Applicant's arguments with respect to claims 24-44 have been considered but are moot in view of the new grounds of rejection.


Additionally, in response to Applicant's arguments the recitation that has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heba Elkassabgi whose telephone number is 571-272-2023. The examiner can normally be reached on Weekdays, 9:00 am to 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on 571-272-2044. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Heba Elkassabgi 
United States Patent and Trademark Office
Patent Examiner- AU 2834
Class 310- Electrical Generator/Motor Structure
Class 290- Prime Mover Dynamo Plants


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